

**THIS OPINION WAS NOT WRITTEN FOR PUBLICATION**

The opinion in support of the decision being entered today  
(1) was not written for publication in a law journal and  
(2) is not binding precedent of the Board.

Paper No. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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***Ex parte*** BIRNEY D. DAYTON

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Appeal No. 95-1461  
Application 08/007,060<sup>1</sup>

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ON BRIEF

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Before KRASS, FLEMING and TORCZON, ***Administrative Patent Judges.***  
FLEMING, ***Administrative Patent Judge.***

**DECISION ON APPEAL**

This is a decision on appeal from the final rejection of  
claims 1 through 6, 8, 9 and 18 through 24, all of the claims  
present in the application. Claims 10 through 17 have been

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<sup>1</sup>Application for patent filed January 21, 1993. According  
to appellant, this application is a divisional of application  
07/614,230, filed November 15, 1990, now abandoned.

canceled.

Appellant has filed an amendment after appeal, November 7, 1994, which cancels claim 7. Therefore, claims 1 through 6, 8, 9 and 18 through 24 are properly before us on appeal.

The invention relates to a switch composed of identical switch modules.

Independent claim 1 is reproduced as follows:

1. A crosspoint switch having M input terminals and N output terminals and comprising (M/m) times (N/n) crosspoint switch modules each having m input conductors, n output conductors, means operable selectively for interconnecting any one of the m input conductors and any selected set of the n output conductors, n input expansion conductors, and n input expansion crosspoint elements operable selectively to connect the n input expansion conductors to the n output conductors respectively, (M/m) of the modules having their input conductors connected to the M input terminals respectively of the crosspoint switch, (N/n) of the modules having their output conductors connected to the N output terminals respectively of the crosspoint switch, the input conductors of the first module being connected to respective input conductors of a second module and the output conductors of the first module being connected to respective input expansion conductors of a third module.

The references relied on by the Examiner are as follows:

Georgiou	4,635,250	Jan. 06, 1987
Franaszek	4,929,940	May 29, 1990

Claims 1, 2, 6 and 21 through 24 stand rejected under 35 U.S.C. § 102 as being anticipated by Georgiou. Claims 1

through 6, 8, 9 and 18 through 24 stand rejected under 35 U.S.C. § 103 as being unpatentable over Georgiou and Franaszek.

Rather than repeat the arguments of Appellant or the Examiner, we make reference to the briefs<sup>2</sup> and the answer for the details thereof.

#### ***OPINION***

After a careful review of the evidence before us, we do not agree with the Examiner that claims 1, 2, 6 and 21 through 24 are anticipated under 35 U.S.C. § 102 by Georgiou or that claims 1 through 6, 8, 9 and 18 through 24 are unpatentable under 35 U.S.C. § 103 over Georgiou and Franaszek.

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<sup>2</sup>Appellant filed an appeal brief on July 6, 1994. We will refer to this appeal brief as simply the brief. Appellant filed a reply appeal brief on November 7, 1994. We will refer to this reply appeal brief as the reply brief. The Examiner responded to the reply brief in a supplemental response, mailed March 20, 1995, stating that the reply brief has been entered and considered and that no further response by the Examiner is deemed necessary. The Appellant also filed an amendment after appeal to the claims on November 7, 1994. In the supplemental response, March 20, 1995, the Examiner indicates that the amendment has been entered into the record. We note that the record has not entered this amendment and direct the Examiner to formally enter this amendment upon receiving the file from the board. For purposes of this appeal, we will consider the amendment entered and consider these claims before us on appeal.

It is axiomatic that anticipation of a claim under § 102 can be found only if the prior art reference discloses every element of the claim. **See *In re King***, 801 F.2d 1324, 1326, 231 USPQ 136, 138 (Fed. Cir. 1986) and ***Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.***, 730 F.2d 1452, 1458, 221 USPQ 481, 485 (Fed. Cir. 1984).

In the brief and the reply brief, Appellant argues that the Examiner has failed to show that Georgiou teaches all of the claimed elements of Appellant's claims. In particular, Appellant argues that the Examiner has failed to show that Georgiou teaches n input expansion conductors as recited in the claims. We note that Appellant's claims 1 through 6, 8, 9, 18 through 20 and 24 recite "n input expansion conductors" and Appellant's claims 21 through 23 recite "n input expansion terminals."

The Examiner argues on page 7 of the answer that Georgiou teaches five input expansion conductors and seven output conductors. However, Appellant argues that the claims require there should be one input expansion conductor for each output conductor.

We note that the claims do require the same number, n, input expansion conductors and output conductors. After a careful review of Georgiou, we fail to find that the Examiner has shown

that Georgiou discloses every element of Appellant's claims. Therefore, we find that Georgiou fails to teach all of the limitations of claims 1, 2, 6 and 21 through 24, and thereby the claims are not anticipated by Georgiou.

Claims 1 through 6, 8, 9 and 18 through 24 are also rejected under 35 U.S.C. § 103 as being unpatentable over Georgiou and

Franaszek. It is the burden of the Examiner to establish why one having ordinary skill in the art would have been led to the claimed invention by the express teachings or suggestions found in the prior art, or by implications contained in such teachings or suggestions. ***In re Sernaker***, 702 F.2d 989, 995, 217 USPQ 1, 6 (Fed. Cir. 1983). "Additionally, when determining obviousness, the claimed invention should be considered as a whole; there is no legally recognizable 'heart' of the invention." ***Para-Ordnance Mfg. v. SGS Importers Int'l, Inc.***, 73 F.3d 1085, 1087, 37 USPQ2d 1237, 1239 (Fed. Cir. 1995), ***cert. denied***, 117 S.Ct. 80 (1996), ***citing W. L. Gore & Assocs., Inc. v. Garlock, Inc.***, 721 F.2d 1540, 1548, 220 USPQ 303, 309 (Fed. Cir. 1983), ***cert. denied***, 469 U.S. 851 (1984).

On page 4 of the answer, the Examiner states that Georgiou

discloses all of the structure that corresponds to the claimed limitations but does not include all the claimed terminology. The Examiner argues that it would have been obvious to one of ordinary skill in the art to have included the input, output and expansion conductors as well as the expansion crosspoint elements as claimed because the conductors and gate drivers of Georgiou can at least operate as such.

However, after a review of both Georgiou and Franaszek, we fail to find any teaching or suggestion of the Appellant's claimed input expansion conductors. We are not inclined to dispense with proof by evidence when the proposition at issue is not supported by a teaching in a prior art reference or shown to be common knowledge of unquestionable demonstration. Our reviewing court requires this evidence in order to establish a ***prima facie*** case. ***In re Knapp-Monarch Co.***, 296 F.2d 230, 232, 132 USPQ 6, 8 (CCPA 1961); ***In re Cofer***, 354 F.2d 664, 668, 148 USPQ 268, 271-72 (CCPA 1966).

In view of the foregoing, the decision of the Examiner rejecting claims 1 through 6, 8, 9 and 18 through 24 is reversed.

***REVERSED***

ERROL A. KRASS	)	
Administrative Patent Judge	)	
	)	
	)	
	)	BOARD OF PATENT
MICHAEL R. FLEMING	)	APPEALS AND
Administrative Patent Judge	)	INTERFERENCES
	)	
	)	
RICHARD TORCZON	)	
Administrative Patent Judge	)	

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